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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,258

12/09/2003

James M. Peck

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

03/18/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com
lhowd@its.jnj.com
gsanche@its.jnj.com

Office Action Summary	Application No. 10/731,258	Applicant(s) PECK ET AL.	
	Examiner Mathieu D. Vargot	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-26 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-26 and 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/09, 4/16/09 & 9/4/09</u> . | 6) <input type="checkbox"/> Other: _____ |

1.Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is rejected essentially for reasons of record, since it is unclear exactly which lenses are encompassed by the patent applications as recited in the claim. In essence, this claim constitutes an “omnibus” claim—ie, “as substantially depicted”—and these claims have always been considered to be indefinite since it is not clear exactly what is being specified.

2.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent Application 2,078,760 in view of Morinaga et al for reasons of record as set forth in paragraph 2 of the previous action.

3.Claims 1 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese document 52-93398 in view of Neeffe for reasons of record as set forth in paragraph 3 of the previous action.

4.Claims 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese document 52-93398 in view of Neeffe and Morinaga et al for reasons of record as set forth in paragraph 4 of the last action.

5. Applicant's arguments filed September 4, 2009 have been fully considered but they are not persuasive. First of all, applicant is correct in assessing that it was Japanese -398 that should have been included in the discussion of the rejection in paragraph 4 of the last action. The occurrence of "British -760" was an unfortunate typo that should have been –Japanese -398--, as set forth in the statement of the rejection preceding the discussion thereof.

Applicant's comments have been noted but are simply not persuasive of error in the rejections applied. While applicant feels that instant claim 11 is definite as written, a reference to an application is submitted to render the claim indefinite as to which materials are actually encompassed. Concerning the art rejections, it should be noted that the instant claims are directed to a package provided with an additive and having a certain average roughness on the inner surface. The package does not know its purpose—ie, that it is to contain an ophthalmic device in solution—and hence arguments directed to the purpose of the package are submitted to be not in point. While applicant may want the package to contain a lens, the prior art package need not contain such an item. All that is required is that the structural limitations are, or would have been obvious, to one of ordinary skill in the art for a package containing whatever item desired. It is respectfully submitted that such has been shown in the rejections applied and not successfully rebutted by applicant. For instance, while Morinaga may teach the instant surface roughness for an exterior of a molded part, it is the mold surface itself that provides this roughness and the reference teaches that such a roughness would be a roughness desired for any plastic molded article that would have

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a smooth surface. Such a surface would also be desirable on the inside of the beaker of Japanese -398 or the container of British -760. Hence, it is submitted that the receptacles of either of Japanese -398 or British -760 would be beneficially made with an inner surface of roughness generally taught in Morinaga. Since the receptacles of the prior art do not have to be used to hold a lens, it is immaterial that British -760 not teach this functionality—or that Japanese -398 not teach it, either. Applicant's comments with respect to Neefe are not well taken. Neefe is merely applied to teach that incorporation into the material or coating the material would be equivalent methods of incorporating an additive into/onto a material so that the material would have the benefits afforded by the additive. Neefe is not being relied upon to teach the instant additive, which is taught in either British -760 or Japanese -398.

6.THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
March 14, 2010

/Mathieu D. Vargot/
Primary Examiner, Art Unit 1791